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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,319

11/14/2003

Sumita Rao

UTL 00387

1215

7590

12/15/2006

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EXAMINER

PRENDERGAST, ROBERTA D

ART UNIT

PAPER NUMBER

2628

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,319

Applicant(s)

RAO, SUMITA

Examiner

Roberta Prendergast

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-25 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 13 concludes with "dividing the set of images into sequential subsets of images, each subset having a size up to a maximum size, where individual images have no link to another image, being indicative of an animation segment; associating a subset identifier with each respective subset; associating an action instruction with each respective segment; and wherein the action instruction associated with one subset identifies another one of the subsets." Independent claim 13 does not appear to produce a tangible result since nothing is done once the set of images is divided into the sequential subsets of images.

Claims 14-16 dependent upon non-statutory independent claim 13 do not contain any additional statutory subject matter and are similarly rejected under 35 U.S.C. 101.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is "useful, tangible and concrete."

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result.

Claims 20-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A set of animation segment files, in computer readable format comprising a first segment file on a computer readable medium and storing a first subset of displayable images, the images not linked to each other; a callback instruction associated with the first segment file; a second segment file on the computer readable medium and storing a second subset of displayable images, the images not linked to each other; a file identifier associated with the second segment file; wherein the callback instruction is indicative of the file identifier, the first segment loadable to a memory readable by an animation engine and the second segment loadable to the memory after at least a portion of the memory used by the first segment has been designated as available for loading is a non-functional data structure and is therefore non-statutory.

Data structures not claimed as embodied in computer-readable material are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized.

Further, when nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance.

Claims 24-25 and 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 24 concludes with "loading the first media object into memory usable for presenting the first media object; retrieving the callback identifier that was provided along with the first media object; using the callback identifier to load the second media object into memory usable for presenting the second media object where the animation file has at least a first and second segment associated with it, each segment comprising at least one image, each image being a displayable image, the first segment identifying a first set of images not linked to each other if there are a plurality of images, the second segment identifying a second subset of images not linked to each other if there are a plurality of images, where each segment has a size up to a maximum size, the maximum size being related to a maximum amount of memory usable for loading images." Independent claim 24 does not appear to produce a tangible result since nothing is done to the first and second media objects once they have been loaded into memory.

Claims 25 and 28-30 dependent upon non-statutory independent claim 24 do not contain any additional statutory subject matter and are similarly rejected under 35 U.S.C. 101.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is "useful, tangible and concrete."

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18, 20-25 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 1, lines 13-16, have been amended to include the limitation "...generating a first segment file indicative of the first set of images, the first set of

images not linked to each other; generating a second segment file indicative of the second set of images, the second set of images not linked to each other...”.

Independent claim 13, lines 5-6, have been amended to include the limitation “...dividing the set of images into sequential subsets of images, each subset having a size up to a maximum size, where individual images have no link to another image...”.

Independent claim 17, lines 4-5 and 11-12, have been amended to include the limitations “...retrieving a first segment file, the first segment file identifying a first subset of images, the first subset of images not linked to each other...” and “...retrieving a second segment file, the second segment file identifying a second subset of images, the second set of images not linked to each other...”.

Independent claim 20, lines 3-4 and 6-7, have been amended to include the limitations “...a first segment file on a computer-readable medium and storing a first subset of displayable images, the images not linked to each other...” and “...a second segment file on a computer-readable medium and storing a second subset of displayable images, the images not linked to each other...”.

Independent claim 24, lines 16-18, have been amended to include the limitation “...the first segment identifying a first set of images not linked to each other if there are

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a plurality of images, the second segment identifying a second subset of images not linked to each other if there are a plurality of images...".

Examiner respectfully submits that these particular limitations are not found in the disclosure of the invention as originally filed on 11/14/2003 and therefore the added material is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments filed 9/1/2006, with regards the rejection of claims 20-23 under 35 U.S.C. 101, have been fully considered but they are not persuasive.

Applicant argues "...Claim 20 has been amended to show specific, concrete action on memory readable by an animation engine as it relates to the two segments previously claimed. Applicant believes this amendment defines sufficient structural, functional interrelationships, and resulting actions in a memory to be patentable subject matter. Since claims 21-23 inherit the elements from claim 20, for the same reason claims 21-23 also now recite patentable subject matter...".

Examiner respectfully submits that amending claim 20 to read "...the first segment loadable to a memory readable by an animation engine and the second segment loadable to the memory after at least a portion of the memory used by the first segment has been designated as available for loading..." does not overcome the

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rejection under 35 U.S.C. 101 because the claim is written to a set of files which are data structures that are not capable of causing functional change in the computer.

Applicant's arguments with respect to claims 1-18, 2-25 and 28-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberta Prendergast whose telephone number is (571) 272-7647. The examiner can normally be reached on M-F 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on (571) 272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP 11/30/2006


ULKA CHAUHAN
SUPERVISORY PATENT EXAMINER